

REMARKS

Reconsideration And Allowance Are Respectfully Requested.

Claims 1-41 and 52-61 are currently pending. Claims 42-51 have been canceled and claims 52-61 have been added. No other claims have been amended. No new matter has been added. Reconsideration is respectfully requested.

Applicant would first like to thank Examiner Passaniti for providing one month to respond to the omissions found in the reply filed February 5, 2001. In accordance with the Office Action of February 21, 2001, Applicant submits the present Amendment intended to replace the Amendment filed February 5, 2001.

Specifically, Applicant has canceled claims 42-51 and added new claimed 52-61. The amendment is made in an effort to incorporate changes to claims 42, 46, 47, 48 and 51 as originally filed. With this in mind, claims 52, 56, 57, 58 and 61 are respectively amended versions of originally filed claims 42, 46, 47, 48 and 51. Similarly, claims 53, 54, 55, 59 and 60 are respectively substantially identical version (apart from dependency) of claims 43, 44, 45, 49 and 50. For convenience in reviewing these new claims, Applicant presents claims 52, 56, 57, 58 and 61 with bracketing and bolding showing the changes made relative claims from these claims as originally filed claims 42, 46, 47, 48 and 51.

42. (Amended) A golf club shaft having a distal end and butt end, comprising:
a tubular section including a first end located at the butt end of the golf club shaft and a second end positioned slightly short of the distal end of the golf club shaft;
an insert secured to the second end of the [first member] tubular section, the insert extends from the second end of the tubular section to the distal end of

the golf club shaft and includes a tubular first end securely coupled to the second end of the first member and a tubular second end shaped and dimensioned [which is ultimately secured] for secure attachment within a hosel of [to] a golf club head;

the insert being formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball.

46. (Amended) The golf club shaft according to claim 42, wherein the insert includes a central section and a pair of couplers formed on opposite ends of the central[s] section, the central section being approximately 0.5 inch[es] in length.[.]

47. (Amended) A golf club shaft having a distal end and butt end, comprising:

a tubular section including a first end located at the butt end of the golf club shaft and a second end positioned slightly short of the distal end of the golf club shaft;

a[n] semi-rigid insert secured to the second end of the [first member] tubular section, the insert extends from the second end of the tubular section to the distal end of the golf club shaft and includes a tubular first end securely coupled to the second end of the first member and a tubular second end [which is ultimately secured] shaped and dimensioned for secure attachment within a hosel of [to] a golf club head;

the insert being formed from a material controlling the stiffness at the distal end of the golf club shaft upon striking a golf ball to thereby stabilize a golf-club head secured to the distal end of the golf club shaft.

48. (Amended) The golf club shaft according to claim 42, wherein the tubular section is made from a material chosen from the group consisting of steel, graphite and fiberglass.

51. (Amended) The golf club shaft according to claim 42, wherein the insert includes a central section and a pair of couplers formed on opposite ends of the central[s] section, the central section being approximately 0.5 inch[es] in length.

In addition, and in place of the substitute specification filed with the Amendment of February 5, 2001, Applicant now submits amendments to the specification as originally filed in the present reissue application such that it conforms with the specification as issued with U.S. Patent No. 5,735,752. Specifically, Page 1, lines 2-4, Page 1, line 21, to Page 2, line 6, Page 15, lines 1-10, and Page 17, lines 8-11 have been replaced. The amendments relating to these sections of the specification are being submitted to obviate the errors on filing and to place the specification of the present reissue application in conformance with the specification of the patent as issued.

The proceeding amendments and comments are believed to correct the omissions of the Amendment filed February 5, 2001.

As to the issues addressed in the November 3, 2000, Applicant would first like to thank Examiner Passaniti for indicating the allowable subject matter found in claims 1-41. In addition, Applicant would like to note that support for the limitations in claims 52 and 57 regarding the shape of the insert may be found in Figures 6 and 7. Support for the limitations in claims 52 and 57 regarding the rigidity of the insert may be found at Column 5, line 47 and, Column 6, line 32, for example.

The Office Action of November 3, 2000 objects to the specification under 37 CFR 1.173 for failing to include the entire specification and claims of the patent, with the matter to be omitted by reissue enclosed in square brackets, and any additions made by the reissue underlined, so that the old and new specifications and claims may be readily compared. With

this in mind, Applicant submits a amendments to the specification as discussed above. If additional corrections are required, the Examiner is urged to contact the undersigned.

In addition, the Examiner has objected to the reissue oath/declaration as not stating “that all errors which are being corrected in the reissue application up to the time of filing the oath/declaration arose without any deceptive intention on the part of applicant.” With this in mind, Applicant previously submitted a new declaration as required by the Examiner with the Amendment filed February 5, 2001 (copy enclosed).

As to the requirement that the original patent, or an affidavit or declaration as to its loss or inaccessibility, be received before the reissue application is allowed, Applicant is currently attempting to locate the original patent and will file the appropriate affidavit or declaration if the original patent is not located.

Claims 42-51 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based. Specifically, the Office Action suggests “the insert is no longer referred to as a unitary insert, nor is the insert detailed as being at least as rigid as the tubular section, nor is the insert described as being shorter than the tubular section. A review of the original application for the patent shows that the specific term ‘unitary’ and specific phrases ‘at least as rigid as the tubular section’ and ‘shorter than the tubular section’ were part of the language added to the claims and argued by the applicant to specifically overcome the rejections of the original claims and to place the claims in condition for allowance.”

Applicant respectfully contends that new independent claims 52 and 57 are substantially distinct from those prosecuted during the original application for patent. Specifically, claims 52 and 57 attempt to remedy the inventor's original failure to appreciate the significance of an insert secured at the distal end of the shaft for enhancing swing control, stiffness and flex control, shock absorption and vibration elimination or reduction. As such, the fact that new claims 52 and 57 do not include phrases such as "unitary", "at least as rigid as the tubular section" and "shorter than the tubular section" does not reflect Applicant's intention to recapture subject matter originally surrendered. Rather, the lack of these terms in the current claims is a result of the focus on subject matter previously not considered during the original prosecution of the present application.

For example, and with reference to claim 52, nowhere in the original prosecution did the inventor attempt to claim a golf club shaft wherein an insert is secured to the second end of a first member, the insert being formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball. Further, and with reference to claim 57, nowhere in the original prosecution does the inventor attempt to pursue patent coverage relating to an insert being formed from a material controlling the stiffness at the distal end of the golf club shaft upon striking a golf ball to thereby stabilize a golf club head secured to the distal end of the golf club shaft. With this in mind, Applicant respectfully requests that the rejection under 35 U.S.C. § 251 be withdrawn.

With regard to the rejections under 35 U.S.C. § 112, Applicant has canceled claims 42-51 and replaced the same with revised claims 52-61. The new claims have been written in the manner suggested by the Examiner. These claims are now believed to comply with 35 U.S.C. § 112, 2nd paragraph, and Applicant respectfully requests that the rejection thereof be withdrawn.

With regard to the rejections based upon prior art, claims 42 and 47 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,362,048 to Haste (Haste). Claims 44, 45, 49 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Haste. Claims 46 and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Haste in view of U.S. Patent No. 4,555,111. These rejections are respectfully traversed in view of the preceding amendments and the remarks which follow.

Applicant has presented new claims 52 and 57 which substantially define a golf club shaft including a distal end and a butt end. The golf club shaft includes a tubular section having a first end located at the butt end of the golf club shaft and a second end positioned slightly short of the distal end of the golf club shaft. The golf club shaft further includes an insert secured to the second end of the tubular section. The insert extends from the second end of the tubular section to the distal end of the golf club shaft and includes a tubular first end securely coupled to the second end of the tubular member and a tubular second end shaped and dimensioned for secure attachment within a hosel of a golf club head. The insert is formed from a material controlling the stiffness at the distal end of the golf club shaft upon

striking the golf ball to thereby stabilize the golf club head secured to the distal end of the golf club shaft. The insert is further formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball.

In contrast to the claimed invention, Haste discloses a resiliently yieldable connector positioned between a golf club head and a shaft. The connector 16 acts as a spring to isolate the reaction of the club head from the shaft when the ball is struck. The Office Action suggests that the fact that the connector 16 is more resiliently yieldable than the head of the shaft results in a connector 16 designed “to absorb vibrations and act as a spring to provide cushioning.” While Haste does disclose a connector acting as a spring, Haste does not disclose that the connector functions by absorbing vibrations and it is Applicant’s opinion that no support exists for the Office Action’s contention regarding the connector’s ability to absorb vibrations. In fact, it is Applicants’ opinion that it is highly likely vibrations emanating at the club head will transmit through the spring connector 16 and up through the shaft of the golf club. This is in direct contrast to the golf club shaft claimed in claim 52.

In addition to Haste’s failure to disclose a vibration absorbing insert, Haste also fails to disclose an insert having a tubular second end shaped and dimensioned for secure attachment within a hosel of a golf club head. In contrast to the claimed second end, Haste discloses a folded connector 16 which is connected to the club head in an undefined manner. However,

it is clear that the connector 16 is not secured to the hosel (the disclosed club head has no hosel) and the second end of the connector 16 does not have a tubular shape permitting attachment within the hosel of a club head.

Further, and with regard to claim 57, Applicant has defined the insert as being a semi-rigid insert. Haste, however, discloses a connector 16 designed to be resiliently yieldable when secured to the shaft of a golf club.

In view of the shortcomings of Haste when compared to amended claims 52 and 57, it is Applicant's opinion that claims 52 and 57 overcome the disclosure of Haste and Applicant respectfully requests that the rejection under 35 U.S.C. § 102(e) be withdrawn.

As mentioned above, claims 44, 45, 49 and 50 (corresponding to new claims 54, 55, 59 and 60) stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Haste. These claims generally define specific material constructions for the claimed insert. For example, claims 54 and 59 defined that the insert is made from a Lexan or fiberglass composite and claims 55 and 60 define that the insert is made from titanium. In contrast to the claimed invention, Haste discloses a connector 16 preferably formed from spring steel. Despite Haste's failure to disclose a connector 16 manufactured from the materials claimed in claims 54, 55, 59 and 60, the Office Action suggests that it would have been obvious to modify the device disclosed by Haste by fabricating "the yieldable connector (16) from any of a number of convenient materials in order to take advantage of the properties of the material(s)." Applicant respectfully traverses this contention and requests that the Examiner cite prior art

supporting this contention if the rejection is maintained in subsequent Office Actions.

Specifically, the claimed materials defined in claims 54, 55, 59 and 60 offer golfers utilizing the claimed invention various striking characteristics neither considered nor suggested by Haste. The claimed materials provide the desired strength, rigidity, control and vibration absorbing characteristics contemplated for optimizing the function of the shaft disclosed and claimed. With this in mind, it is Applicant's opinion that the rejection of claims 54, 55, 59 and 60 under 35 U.S.C. § 103(a) is improper and Applicant respectfully requests that the rejection be withdrawn.

With regard to claims 46 and 51 (corresponding to new claims 56 and 61), Applicant defines a golf club shaft "wherein the insert includes a central section and a pair of couplers formed on opposite ends of the central section, the central section being approximately 0.5 inch in length." As discussed above, Haste provides no details as to the specific manner in which the connector 16 is secured to the shaft and/or the club head. However, it is known from the drawings of Haste that the connector 16 is not secured to the club head via a hosel and does not have a tubular shape adapted for attachment to the hosel of a conventional golf club. With this in mind, the Office Action's suggestion that it would have been obvious to utilize the connectors disclosed by Alvarez in modifying the connector 16 disclosed by Haste is improper.

Alvarez is concerned with attaching tubular members by inserting a female member within a male member, while Haste is concerned with somehow attaching a rectangular flap

to the uppermost portion of a uniquely formed club head. The construction and attachment mechanisms contemplated by Haste and Alvarez are very different and one looking to modify the connecting mechanism disclosed by Haste would certainly not look to Alvarez.

Further, and with regard to the suggestion that it would have been obvious to modify the connector of Haste to a length of approximately 0.5 inch in length, it is Applicant's opinion that Haste requires a longer connector to provide the resiliently yieldable member contemplated in accordance with disclosed invention. As such, modifying the connector 16 of Haste to increase rigidity would be contrary to the contemplated invention of Haste and Applicant respectfully considers such a modification to be improper. With the foregoing in mind, it is Applicant's opinion that the rejection of claims 46 and 51 under 35 U.S.C. § 103(a) is improper and Applicant respectfully requests that the rejection be withdrawn.

As to claims 43 and 48 (corresponding to new claims 53 and 58), the Office Action presents no rejection other than the rejection under 35 U.S.C. § 112, 2nd paragraph. Applicant, therefore, asks whether these claims would be allowable if rewritten in independent form or whether these claims are in fact unpatenable for reasons similar to those presented in the outstanding Office Action.

For the foregoing reasons, it is Applicant's opinion that claims 1-41 and 52-61 overcome the prior art of record. As such, Applicant respectfully requests that the rejections be withdrawn and the application pass to allowance.

It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicants' representative at the below number.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Howard N. Flaxman". The signature is fluid and cursive, with the first name "Howard" and last name "Flaxman" clearly distinguishable.

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